REMARKS

Claims 1-40 are currently pending. Applicant notes that the references relied upon by the Examiner in the Office action dated January 11, 2005, Anonychuk (U.S. Patent No. Re. 37,150) and Gruber (U.S. Patent No. 6,413,290), have not been listed on a Notice of References Cited form. Applicant respectfully requests that these references be listed on a Notice of References Cited form.

The Examiner rejected claims 1-4, 16-17, and 28-29 under 35 U.S.C. §102(b) as being anticipated by Ernst (U.S. Patent No. 6,231,630).

Claim 1 defines a filter device for an engine that is operable to support a filter element. The filter device includes a housing that defines a filter receiving space having a first end and a second end. The first end and second end define an axial length therebetween. A biasing element integrally-formed as one piece with the housing is disposed adjacent the first end.

Ernst does not teach or suggest, among other things, a filter device that includes a biasing element integrally-formed as one piece with the housing. Rather, Ernst discloses an air filter for the intake of an internal combustion engine that includes a housing and a filter insert. As shown in Fig. 3, the housing 30 includes a spring clip 38 that is coupled to the housing 30. The spring clip engages a filter insert 26 that holds a filter element in the desired position. As is clearly illustrated, the spring clip 38 is not integrally-formed as one piece with the housing 30. The Examiner points to Fig. 3 and col. 3, lines 21-31 in support of the 35 U.S.C. §102(b) rejections. However, there is nothing in this, or any of the disclosure of Ernst that teaches or suggests integrally-forming a biasing element and a housing as a single piece.

In light of the foregoing, Ernst does not teach or suggest each and every element of claim 1. As such, claim 1 is allowable. In addition, claims 2-15 depend from claim 1 and are allowable for these and other reasons.

Claim 16 defines an air cleaner assembly for an engine. The air cleaner includes a base including a filter support and a base engagement portion. The air cleaner also includes a filter element that defines a longitudinal direction and a cover that includes an integrally formed biasing element and a cover engagement portion. The base engagement portion is interconnected with the cover engagement portion to position the biasing member adjacent the filter element to bias the filter element in the longitudinal direction.

Ernst does not teach or suggest, among other things, an air cleaner that includes a cover that includes an integrally formed biasing element. As discussed with regard to claim 1, Ernst discloses a filter assembly that includes a spring clip 38 that engages the housing 30 to hold the filter housing 26 and filter element 35 in the desired position. The spring clip 38 is separate from the housing 30 and may either engage the housing 30 or may be pinned to the housing 30 during assembly. There is nothing in Ernst that suggests that the spring clip is, or even could be, integrally-formed as part of the housing.

In light of the foregoing, Ernst does not teach or suggest each and every element of claim 16. As such, claim 16 is allowable. In addition, claims 17-27 depend from claim 16 and are allowable for these and other reasons.

Claim 28 defines a cover for use with an engine filter base and a filter element. The cover includes a shell, a biasing element integrally-formed as one piece with the shell, and an attachment portion connected to the shell and adapted to be interconnected to the filter base such that the filter element is sandwiched between the biasing element and the filter base.

Ernst does not teach or suggest, among other things, a cover that includes a shell and a biasing element integrally-formed as one piece with the shell. As discussed, Ernst discloses an air filter that includes a housing 30, a spring clip 38, a filter insert 26 and a filter element 35. The spring clip 38 engages the housing 30 and the filter insert 26 to hold the filter element 35 in the desired position. However, as is clearly illustrated and disclosed, the spring clip 38 attaches to the housing 30 and is not integrally-formed as one piece with the shell.

In light of the foregoing, Ernst does not teach or suggest each and every element of claim 28. As such, claim 28 is allowable. In addition, claims 29-40 depend from claim 28 and are allowable for these and other reasons.

The Examiner rejected claims 5-15, 18-27, and 30-40 under 35 U.S.C. §103(a) as being unpatentable over any one of Erdmannsdörfer (U.S. Patent No. 4,632,682), Uebelhoer (U.S. Patent No. 5,429,101), or Kasten (U.S. Patent No. 2,413,769).

Claims 5-15 depend from claim 1, claims 18-27 depend from claim 16, and claims 30-40 depend from claim 28. Claim 1 includes a biasing element integrally-formed as one piece with the housing, claim 16 includes a cover including an integrally formed biasing element, and claim 28 includes a biasing element integrally-formed as one piece with the shell.

None of Erdmannsdörfer, Uebelhoer, or Kasten teach or suggest a biasing element integrally-formed as part of a housing or shell. Rather, Erdmannsdörfer discloses an oil-separating air filter that includes a housing 30, a filter 43, and a biasing element 46. However, the biasing element 46 is separate from the housing. Uebelhoer discloses a similar device that includes a housing 30, a filter 43, and a spring (unnumbered). Kasten discloses a filter that includes a housing 14, a filter 29, and a spring 34 that is separate from the housing 14 and the filter 29.

The Examiner acknowledges that none of the references cited teach or suggest a biasing member that is integrally-formed with a housing or shell. Rather, the Examiner relies solely on legal precedent that is more than a century old and simply states that this limitation is obvious "since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art." Office action dated July 6, 2005 citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

While the Examiner may use legal precedent as the basis for an obviousness rejection, the prior legal decision must be sufficiently similar to the application. See MPEP §2144 stating "If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." Furthermore, it is not appropriate for the Examiner to rely solely on case law to support an obviousness rejection if the applicant has demonstrated the criticality of the limitation in question. See MPEP §2144 stating "If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection."

In the present case, Applicant has included the limitation of a biasing member integrally-formed as part of a housing or shell in each and every claim. This limitation goes to the heart of the invention and is clearly critical for the proper function of the claimed device. As such, Applicant contends that an obviousness rejection based solely on case law is improper for the limitation of an integrally-formed biasing member.

Furthermore, the Examiner has failed to note a legal decision that is sufficiently similar to the application under examination. The fact that one legal decision has held the combination of two elements into one element to be obvious does not mean all such combinations are obvious. See MPEP 2144.04 V(B) discussing In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). In Larson,

> a claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding,

> among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.

MPEP 2144.04 V(B). However, in Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) the court held that the combination of two components into a single integral component was not obvious. In Schenck,

> claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.

MPEP 2144.04 V(B).

The Examiner cites only Howard v. Detroit Stove Works, 150 U.S. 164 (1893) in support of the 35 U.S.C. §103(a) rejection. However, the Examiner's interpretation of Howard is overly broad. In Howard, the patent was directed to a grate for a stove. The prior art contained all of the elements of the grate, except that it was cast in two pieces while the patented device was cast as one piece. See Howard at 169-170. The court concluded "it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together." Howard v. Detroit Stove Works, 150 U.S. 164, 170 (1893). The two components discussed in Howard formed a single non-moving grate. As such, the two components did not have to move with respect to one another and could be made using the same manufacturing process (i.e., casting). Because both components operate in similar conditions and can be manufactured using the same process, it is likely that they could be made using the same or similar material.

Unlike Howard, the prior art cited by the Examiner includes coil springs that are generally made from a material and using a process that is quite different from that used to make the housing. In addition, the spring must be able to move with respect to the housing, a feature likely not required by the device of Howard. Thus, the facts of Howard are not similar to those of the application under examination and Howard is not sufficient to support the Examiner's obviousness rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, do not teach or suggest each and every limitation of claims 5-15, 18-27, and 30-40. As such, claims 5-15, 18-27, and 30-40 are allowable.

CONCLUSION

In light of the foregoing, Applicant respectfully submits that claims 1-40 are allowable.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

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